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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,906	10/05/2000	Chan Daigle	25791.37.02	8824

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EXAMINER

NICHOLSON, ERIC K

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,906

Applicant(s)

DAIGLE ET AL.

Examiner

Eric K Nicholson

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 18-30, 34-37, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 18-30, 34-37, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 5. 6) ☐ Other: _____

Claims 25,27,40 and 41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification appears void of any description or disclosure of what exactly the "curing catalyst" is that is claimed in claims 25,27,40 and 41.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,18,28,29,30,34,35 and 36 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by W.O. published application 97/21901 to Campbell et al.. See page 3, lines 5-15 which disclose that the expandable tubular members

“may be threaded” and “may additionally be secured to one another by an suitable means or combination of means, including adhesive...”.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over W.O. published application 97/21901 to Campbell et al. in view of the Jet-Lock III High Fiction Thread Compound available from Jet-Lube, Inc.” noted on page 7, lines 12-23 of the specification noted on page 7, lines 12-23 of the specification. Campbell et al. discloses the claimed invention except for it does not disclose the type of adhesive (page 3, line 14) used in combination with the threads. The Jet-Lock III High Fiction Thread Compound available from Jet-Lube, Inc.” noted on page 7, lines 12-23 of the specification exhibits all of the attributes

claimed in claims 2-6 and 19-23 of the sealant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the Jet-Lube High Friction Thread Compound as the adhesive used in the Campbell et al. device, since the Campbell et al. device is used in the same field of endeavor as that intended for the Jet-Lube thread compound and further since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 7,24-27,37,40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over W.O. published application 97/21901 to Campbell et al. in view U.S. patent 5,426,130 to Thurber. Campbell discloses the claimed device except for it does not disclose the utilization of a primer or catalyst for application of the adhesive (page 3, line 14) used in combination with the threads. Thurber et al. discloses that it is known in the art to provide a thread adhesive with a primer such as heat for better application and adhesion of the resin on the members being joined. See column 20, lines 5-15 and also the use of a catalyst such as benzoyl peroxide as a photo initiator. See column 6, lines 10-25. It would have been obvious to one having ordinary skill in the art at the time the invention was made

to provide the thread adhesive of the W.O. device with a primer as taught by Thurber et al. for a better bond of the resin on the threads and a catalyst as taught by Thurber et al. in order to provide a more secure coupling by insuring a quick and positive mixing of the epoxy materials.

Pertaining to product-by-process claims 18-27,34-36,40 and 41, a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bethanne Dayoan, can be reached on (703) 308-3865. The fax phone number for Technical Center 3600 is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technical Center receptionist whose telephone number is (703) 308-2168.

Ekn - w@h
10/23/01


Eric K. Nicholson
Primary Examiner
Technology Center 3600